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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/456,371    12/08/99    BOLLMANN    H    12010

028484  
BASF CORPORATION  
LEGAL DEPARTMENT  
1609 BIDDLE AVENUE  
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IM52/0601

EXAMINER

ROCHE, L

ART UNIT

PAPER NUMBER

1771

DATE MAILED:

06/01/01

*5*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

|                              |                 |                 |  |
|------------------------------|-----------------|-----------------|--|
| <b>Office Action Summary</b> | Application No. | Applicant(s)    |  |
|                              | 09/456,371      | BOLLMANN ET AL. |  |
|                              | Examiner        | Art Unit        |  |
|                              | Leanna Roche    | 1771            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,9 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,9 and 14 is/are rejected.
- 7) ☐ Claim(s) 9 and 14 is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)                      18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.                      20) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

During a telephone conversation with Fernando Borrego on May 10, 2001 a provisional election was made with traverse to prosecute the invention of Group I, claims 1, 7, 9-18. The supplemental preliminary amendment received on May 23, 2001 affirmed this election, and traverse was withdrawn. Therefore, Claims 2-6 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant's cancellation of claim 8 in Paper No. 2 and cancellation of claims 2-7, 10-13 and 15-18 in Paper No. 4 is acknowledged. Therefore, Claims 1, 9 and 14 remain pending in this application. The amendments to claims 9 and 14 have been entered.

### ***Claim Objections***

Applicant is advised that should claim 9 be found allowable, claim 14 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krech et al. (CA 02240464) in view of Hoppe et al. (USPN 4447486).

Krech is directed to a microcellular polyurethane elastomer with improved dynamic-mechanical characteristics useful in the vibration and shock damping systems of automobiles. Krech discloses a microcellular polyurethane elastomer with a density, tensile strength, elongation at break and tear propagation resistance within the ranges claimed by Applicant.

Krech does not disclose a layer of thermoplastic polyurethane adhered to the microcellular polyurethane elastomer. Hoppe, however, is directed to the sealing of an open-cell polyurethane elastomer using a thin, nonporous skin of polyurethane. Hoppe explains that sealing the polyurethane elastomer with a polyurethane skin prevents water, dust and dirt from penetrating into the open-cells of the elastomer (Column 1 lines 18-62). It would have been obvious to a person having ordinary skill in the art at the time this invention was made to combine the teachings of Krech and Hoppe, motivated by the desire to increase the resistance of the microcellular polyurethane elastomer to penetration by water and dirt.

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Neither Krech nor Hoppe specifically disclose the rebound resilience of the cellular polyurethane elastomer layer. However, it appears that the microcellular layer of Krech is substantially identical to the presently claimed microcellular polyurethane elastomer. Thus, it is believed by the examiner that the microcellular polyurethane elastomer of Krech inherently possesses a rebound resilience within Applicant's presently claimed ranges. See *In re Best*, 195 USPQ 433 footnote 4 (CCPA 1977).

### **Contact Information**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leanna Roche whose telephone number is 703-308-6549. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 703-308-1261. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



lmr  
May 25, 2001



BLAINE COPENHEAVER  
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